

REMARKS

Claims 1-6, 8-14, 16-18 and 25-31 are currently pending in the subject application, and are presently under consideration. Claims 8-14 and 16-18 have been withdrawn. Claims 1-6 and 25-31 are rejected. Claim 1 has been amended to correct a minor error. Claim 26 has been cancelled. Favorable reconsideration of the application is requested in view of the amendments and comments herein.

I. Rejection of Claims 1-6 and 25-31 Under 35 U.S.C. §112, Second Paragraph

Claims 1-6 and 25-31 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Specifically, claim 1 contained an antecedent basis error, reciting a “handheld communications module” in the preamble instead of a “handheld communications device.” This has been corrected in the amendment provided above. It is respectfully requested that this amendment be entered as it overcomes the rejection under 35 U.S.C. §112, second paragraph, and thus reduces the issues for appeal.

II. Rejection of Claims 26 Under 35 U.S.C. §112, First Paragraph

Claim 26 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claim 26 has been cancelled. It is thus respectfully requested that this rejection be withdrawn.

III. Rejection of Claims 1 and 25-31 Under 35 U.S.C. §103(a)

Claims 1 and 25-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,148,261 to Obradovich, et al. ("Obradovich") in view of U.S. Patent No. 6,104,620 to Dudas, et al. ("Dudas"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

The Office Action asserts that it would be obvious for one of skill in the art to employ the shielding of Dudas in the personal communication devices of Obradovich. Dudas describes a shielded PCMCIA memory card slot that allows a spread spectrum radio communicator to be inserted within a portable device to provide communication with a local network. It is respectfully submitted that one of ordinary skill in the art would not seek to combine the shielded card slot of Dudas with the personal communication device of Obradovich in the manner suggested in the Office Action as a skilled artisan would not reasonably expect such a combination to be successful. The Office Action reads Obradovich to utilize a transceiver capable of direct communication with a satellite relay. The applications described for the Dudas system are intended for use within a single facility, *See* Dudas, Col 2, lines 12-34, and would thus require minimal power output at the transceiver.

Implementing the alleged satellite transceiver of Obradovich in an appropriate form for the shielded card slot of Dudas, as suggested in the Office Action, would render the Obradovich system unsuitable for its intended purpose, such that it would be unreasonable for one of skill to expect the proposed combination to produce a functional system. Specifically, it is highly unlikely that the power needed by a satellite transceiver could be provided through the PCMCIA interface of Dudas, and even if the power were provided, the excessive heat produced from a transmitter capable of direct satellite transmission in the L-band would be expected to quickly overheat within a shielded card slot such as that taught in Dudas. Since the PCD of Obradovich is taught as being “cellular-phone-sized,” Obradovich, Col. 2, lines 53-60, the limitations of the card-based approach of Dudas would only be exacerbated by the necessity of scaling the approach for a smaller device. An obviousness rejection based on a combination that has no reasonable expectation of success is improper, *See* MPEP 2143.02, and it is thus respectfully submitted that claim 1 is patentable over the cited art.

Each of claims 25, 27, and 28 depend from claim 1 and are allowable for at least the same reasons. Claims 29-31 recite that the electrically conductive enclosure of claim 1 comprises a conductive back plate configured such that at least a portion of the handheld computing device can be mechanically mounted to the conductive back plate. The Office Action rejects claims 29-

31 with the assertions that Obradovich and Dudas “suggest the benefit of modularity” and “[d]eciding how the modularity takes shape requires only routine skill in the art when there are no unpredictable results.” Office Action, pg. 5. It is respectfully submitted, however, that Obradovich teaches an integral unit, and Dudas merely exploits the existing PCMCIA architecture to add a communication card to a scanner; there is no suggestion of any general benefit of modularity in the cited art, and certainly no suggestion of creating a mountable communications modular such as that claimed in claims 1 and 29-31. Further, it is respectfully submitted that the quoted text above is a misstatement of the rationales presented in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Specifically, a rationale to support an obviousness rejection can be found if *the combination of known elements or the application of known techniques* to a prior art reference would yield predictable results. It is respectfully submitted that the cited art fails to show any elements or techniques suitable for modifying Obradovich to achieve the claimed system. The card based system, as discussed above, is inadequate for the claimed satellite communication, and no alternative appears to be present within the art. It is thus respectfully submitted that claims 29-31 define over the cited art for the above reasons as well as their dependence of claim 1.

IV. Rejection of Claim 2 Under 35 U.S.C. §103(a)

Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Obradovich in view of Dudas as applied to claim 1, and further in view of U.S. Publication No. 2003/0032426 to Gilbert, *et al.* ("Gilbert"). Claim 2 depends from claim 1, and is allowable for at least the same reasons. Gilbert does not remedy the deficiencies of Obradovich and Dudas with respect to claim 1, as described previously. It is thus respectfully submitted that claim 2 is patentable of the cited art, and the withdrawal of this rejection is respectfully requested.

V. Rejection of Claim 3 Under 35 U.S.C. §103(a)

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Obradovich in view of Dudas and Gilbert as applied to claim 2, and further in view of U.S. Publication No.

2005/0162334 to Saunders, *et al.* ("Saunders"). Claim 3 depends, through claim 2, from claim 1, and is allowable for at least the same reasons. Saunders does not remedy the deficiencies of Obradovich, Gilbert, and Dudas with respect to claim 1, as described previously. It is thus respectfully submitted that claim 3 is patentable of the cited art, and the withdrawal of this rejection is respectfully requested.

VI. Rejection of Claims 4 and 5 Under 35 U.S.C. §103(a)

Claims 4 and 5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Obradovich in view of Dudas as applied to claim 1, and further in view of "Xilinx" by Bielby ("Bielby"). Each of claims 4 and 5 depend from claim 1, and is allowable for at least the same reasons. Bielby does not remedy the deficiencies of Obradovich and Dudas with respect to claim 1, as described previously. It is thus respectfully submitted that claims 4 and 5 are patentable of the cited art, and the withdrawal of this rejection is respectfully requested.

VII. Rejection of Claim 6 Under 35 U.S.C. §103(a)

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Obradovich in view of Dudas as applied to claim 1, and further in view of U.S. Publication No. 2005/0114553 to Lada, *et al.* ("Lada"). Claim 6 depends, through claim 5, from claim 1, and is allowable for at least the same reasons. Lada does not remedy the deficiencies of Obradovich and Dudas with respect to claim 1, as described previously. It is thus respectfully submitted that claim 6 is patentable of the cited art, and the withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Applicant respectfully requests reconsideration of this application and that the application be passed to issue.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

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